

***REMARKS***

This is a full and timely response to the outstanding Office action mailed April 16, 2004. Upon entry of the amendments in this response claims 1-49 are pending. More specifically, claims 1, 23, 47, and 49 are amended. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

**I. Present Status of Patent Application**

Claims 1, 5-8, 10-13, 21, 23, 25, 27-30 and 49 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Horstmann *et.al.* (U.S. Patent No. 6,779,022). Claims 14, 22, and 31 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Horstmann. Claims 2-4, 26, 38, and 41-48 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Horstmann in view of Chapman. Claims 9 and 24 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Horstmann in view of Netscape Mail Server Administrator's Guide. Claims 15-20 and 32-37 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Horstmann in view of cc:Mail for Window's User Guide. Claims 39-40 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Horstmann in view of Chapman in further view of cc:Mail. These rejections are respectfully traversed.

**II. Examiner Interview**

Applicant first wishes to express his sincere appreciation for the time that Examiners Swearingen and Winder spent with Applicant's Attorneys during a July 15<sup>th</sup> telephone discussion regarding the above-identified Office Action. Applicant believes that various features described in the patent application and recited in the claims, including applying an instruction to a predetermined set of email messages, the instruction contained in an email message not included in the predetermined set of email messages on a source email server, were discussed during the telephone discussion, and that the outcome of this discussion is addressed herein. During that conversation, Examiners Swearingen and Winder seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Swearingen carefully consider this amendment and response.

### III. Rejections Under 35 U.S.C. §102(b)

#### A. Claims 1, 5-8, 10-13, and 21

Claims 1, 5-8, 10-13, and 21 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Horstmann*. For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 1** as amended recites:

1. A method for managing a predetermined set of email messages previously stored on a source email server from a remote email network, said method comprising the steps of:

(a) receiving an email message at the source email server, ***the email message not included in the predetermined set of email messages previously stored on a source email server, wherein said email message has*** a destination email address in a first field, a code in a second field and ***an instruction in a third field***, wherein said destination email address corresponds to a subscriber account on the remote email network;

(b) checking a database to determine a permission for the destination email address; and

(c) ***applying the instruction to the predetermined set of email messages*** if the permission is granted.

(Emphasis Added)

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 as amended is allowable for at least the reason that *Horstmann* does not disclose, teach, or suggest at least **the email message not included in the predetermined set of email messages previously stored on a source email server, wherein said email message has an instruction in a third field and applying the**

**instruction to the predetermined set of email messages.** As provided by the Examiner in the aforementioned Examiner interview, the “urgent flag” of a message, as disclosed in *Horstmann*, allegedly reads upon an instruction in a message:

communications server 105 dispatches messages to an appropriate receiving device based on the user's needs, as specified by the user to communications server 105. For example, communications server 105 can be configured so that dispatcher 154 dispatches messages flagged as urgent to wireless device 140 via cell receiver 135. Messages flagged as "urgent" need not include the term "urgent," but include some portion of the message that identifies the message as having a higher priority than other messages.

*Horstmann*, col. 4, lines 12-18.

However, even if the “urgent flag” of *Horstmann* is found to read on the instruction, the urgent flag only applies to the message that contains it. The urgent flag does not apply to a separate set of email messages, as claimed. Applicant respectfully submits that *Horstmann* does not disclose an email message with an instruction in a field and applying the instruction to a set of email messages that doesn't include the email message containing the instruction. Therefore, *Horstmann* does not anticipate claim 1, and the rejection should be withdrawn.

Because independent claim 1 as amended is allowable over the prior art of record, dependent claims 5-8, 10-13, and 21 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 5-8, 10-13, and 21 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 5-8, 10-13, and 21 are patentable over *Horstmann*, the rejection to claims 5-8, 10-13, and 21 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 5-8, 10-13, and 21 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from

the prior art of record. Hence there are other reasons why dependent claims 5-8, 10-13, and 21 are allowable.

B. Claims 23, 25, and 27-30

Claims 23, 25, and 27-30 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Horstmann*. For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 23** as amended recites:

23. A method for managing a predetermined set of email messages previously stored on a source email server from a remote email network, said method comprising the steps of:

- (a) populating a database with subscriber email addresses corresponding to subscriber accounts authorized to remotely manage email messages;
- (b) receiving an email message at the source email server, *the email message not included in the predetermined set of email messages previously stored on a source email server, wherein said email message has* a destination email address in a first field, a code in a second field and *an instruction in a third field*, wherein said destination email address corresponds to a subscriber account on the remote email network;
- (c) checking the database to determine a permission for the destination email address; and
- (d) *applying the instruction to the predetermined set of email messages* if the permission is granted.

(Emphasis Added)

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 23 as amended is allowable for at least the reason that *Horstmann* does not disclose, teach, or suggest at least **the email message not included in the predetermined set of email messages previously stored on a source email server, wherein said email**

**message has ... an instruction in a third field and applying the instruction to the predetermined set of email messages.** As provided by the Examiner in the aforementioned Examiner interview, the “urgent flag” of a message, as disclosed in *Horstmann*, allegedly reads upon an instruction in a message:

communications server 105 dispatches messages to an appropriate receiving device based on the user's needs, as specified by the user to communications server 105. For example, communications server 105 can be configured so that dispatcher 154 dispatches messages flagged as urgent to wireless device 140 via cell receiver 135. Messages flagged as "urgent" need not include the term "urgent," but include some portion of the message that identifies the message as having a higher priority than other messages.

*Horstmann*, col. 4, lines 12-18.

However, even if the “urgent flag” of *Horstmann* is found to read on the instruction, the urgent flag only applies to the message that contains it. The urgent flag does not apply to a separate set of email messages, as claimed. Applicant respectfully submits that *Horstmann* does not disclose an email message with an instruction in a field and applying the instruction to a set of email messages that doesn't include the email message containing the instruction. Therefore, *Horstmann* does not anticipate claim 23, and the rejection should be withdrawn.

Because independent claim 23 is allowable over the prior art of record, dependent claims 25 and 27-30 (which depend from independent claim 23) are allowable as a matter of law for at least the reason that dependent claims 25 and 27-30 contain all the steps/features of independent claim 23. Therefore, since dependent claims 25 and 27-30 are patentable over *Horstmann*, the rejection to claims 25 and 27-30 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 23, dependent claims 25 and 27-30 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 25 and 27-30 are allowable.

C. Claim 49

The Office Action rejects claim 49 under 35 U.S.C. 102(e) as being anticipated by *Horstmann*. For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 49** as amended recites:

49. A system for managing a predetermined set of email messages on a source email server from a remote email network, said system comprising:

(a) a registration database on the source server, said registration database comprising a local subscriber account on said source server and an associated destination email address on the remote email network;

(b) a first module on the source email server, wherein when a first email message having a code in a first field, *the first email message not included in the predetermined set of email messages previously stored on a source email server, an instruction in a second field of the first email message* and a sender email address in a sender field is received on the source email server, said first module determines if the sender email address is in the database; and

(c) a second module on the source server, *wherein* if the sender email address is in the database, *the second module applies the instruction to the predetermined set of email messages.*

(Emphasis Added)

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 49 as amended is allowable for at least the reason that *Horstmann* does not disclose, teach, or suggest at least **the first email message not included in the predetermined set of email messages previously stored on a source email server, an instruction in a second field of the first email message and wherein ... the second module applies the instruction to the predetermined set of email messages.** As provided by the Examiner in the aforementioned Examiner interview, the “urgent flag” of a message, as disclosed in *Horstmann*, allegedly reads upon an instruction in a message:

communications server 105 dispatches messages to an appropriate receiving device based on the user's needs, as specified by the user to communications server 105. For example, communications server 105 can be configured so that dispatcher 154 dispatches messages flagged as urgent to wireless device 140 via cell receiver 135. Messages flagged as "urgent" need not include the term "urgent," but include some portion of the message that identifies the message as having a higher priority than other messages.

*Horstmann*, col. 4, lines 12-18.

However, even if the "urgent flag" of *Horstmann* is found to read on the instruction, the urgent flag only applies to the message that contains it. The urgent flag does not apply to a separate set of email messages, as claimed. Applicant respectfully submits that *Horstmann* does not disclose an email message with an instruction in a field and applying the instruction to a set of email messages that doesn't include the email message containing the instruction. Therefore, *Horstmann* does not anticipate claim 49, and the rejection should be withdrawn.

#### **IV. Rejections Under 35 U.S.C. §103(a)**

##### **A. Claims 38-43**

Claims 38 and 41-43 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Horstmann* in view of *Chapman*. Claims 39-40 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Horstmann* in view of *Chapman* in further view of *cc:Mail*. For the reasons set forth below, Applicant respectfully traverses the rejection.

##### **Independent claim 38 recites:**

38. A method for remotely retrieving a first email message from a source email server to a destination email address having a standard email client application, said method comprising the steps of:

- (a) populating a database with subscriber email addresses corresponding to subscriber accounts authorized to remotely retrieve email messages;

(b) *receiving a second email message on the source server, wherein said second email message has the destination address in a message sender field and a code in a predetermined field;*

(c) checking the database to verify the destination email address as an authorized account; and

(d) *sending, in response to the code, the first email message from the source email server to the destination email address.*

(Emphasis Added)

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 38 is allowable for at least the reason that the combination of *Horstmann* and *Chapman* does not disclose, teach, or suggest at least **receiving a second email message on the source server, wherein said second email message has ... a code in a predetermined field and sending, in response to the code, the first email message from the source email server to the destination email address.** As provided by the Examiner in the aforementioned Examiner interview, the “urgent flag” of a message, as disclosed in *Horstmann*, allegedly reads upon a code in a message:

communications server 105 dispatches messages to an appropriate receiving device based on the user's needs, as specified by the user to communications server 105. For example, communications server 105 can be configured so that dispatcher 154 dispatches messages flagged as urgent to wireless device 140 via cell receiver 135. Messages flagged as "urgent" need not include the term "urgent," but include some portion of the message that identifies the message as having a higher priority than other messages.

*Horstmann*, col. 4, lines 12-18.

However, even if the “urgent flag” of *Horstmann* is found to read on the code, the urgent flag only applies to the message that contains it. The urgent flag does not apply to a separate email message, as claimed. Applicant respectfully submits that *Horstmann* does not disclose a second email message with a code in a field and applying the code to a first email message.



Therefore, the cited reference does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 38. *Chapman* does not cure this deficiency. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 38 is allowable.

Because independent claim 38 is allowable over the prior art of record, dependent claims 39-43 (which depend from independent claim 38) are allowable as a matter of law for at least the reason that dependent claims 39-43 contain all the steps/features of independent claim 38. Therefore, since dependent claims 39-43 are patentable over *Horstmann*, the rejection to claims 39-43 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 38, dependent claims 39-43 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 39-43 are allowable.

Additionally, with regard to the rejection of claims 39-40, cc:Mail does not make up for the deficiencies of *Horstmann* noted above. Therefore, claims 39-40 are considered patentable over any combination of these documents.

B. Claims 44-48

Claims 44-48 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Horstmann* in view of *Chapman*. For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 44** recites:

44. A method for remotely managing a first email message on a source email server from an email account on a remote email server, said method comprising the steps of:

(a) *receiving a second email message on the source server, wherein said second email message has a code in a first predetermined field;*

(b) checking a database for a subscriber account corresponding to a message sender field in the second email message; and

(c) ***processing the first email message according to an instruction in a second predetermined field.***

(Emphasis Added)

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 44 is allowable for at least the reason that the combination of *Horstmann* and *Chapman* does not disclose, teach, or suggest at least **receiving a second email message on the source server, wherein said second email message has a code in a first predetermined field and processing the first email message according to an instruction in a second predetermined field**. As provided by the Examiner in the aforementioned Examiner interview, the “urgent flag” of a message, as disclosed in *Horstmann*, allegedly reads upon an instruction in a message:

communications server 105 dispatches messages to an appropriate receiving device based on the user's needs, as specified by the user to communications server 105. For example, communications server 105 can be configured so that dispatcher 154 dispatches messages flagged as urgent to wireless device 140 via cell receiver 135. Messages flagged as "urgent" need not include the term "urgent," but include some portion of the message that identifies the message as having a higher priority than other messages.

*Horstmann*, col. 4, lines 12-18.

However, even if the “urgent flag” of *Horstmann* is found to read on the instruction, the urgent flag only applies to the message that contains it. The urgent flag does not apply to a separate message, as claimed. Applicant respectfully submits that *Horstmann* does not disclose a second message with an instruction in a field and applying the instruction to a first email message. Therefore, the combination of the cited references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 44. *Chapman* does not cure this deficiency. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 44 is allowable.

Because independent claim 44 is allowable over the prior art of record, dependent claims 45-48 (which depend from independent claim 44) are allowable as a matter of law for at least the reason that dependent claims 45-48 contain all the steps/features of independent claim 44. Therefore, since dependent claims 45-48 are patentable over *Horstmann*, the rejection to claims 45-48 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 44, dependent claims 45-48 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 45-48 are allowable.

C. Claim 2-4, 9, and 14-20

Claims 2-4 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Horstmann* in view of *Chapman*. Claim 9 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Horstmann* in view of *Netscape Mail Server Administrator's Guide*. Claim 14 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Horstmann*. Claims 15-20 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Horstmann* in view of *cc:Mail for Window's User Guide*. For the reasons set forth below, Applicant respectfully traverses the rejection.

Because independent claim 1 is allowable over the prior art of record, dependent claims 2-4, 9, and 14-20 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-4, 9, and 14-20 contain all the steps/features of independent claim 1. Therefore, since dependent claims 45-48 are patentable over *Horstmann*, the rejection to claims 2-4, 9, and 14-20 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-4, 9, and 14-20 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 2-4, 9, and 14-20 are allowable.

Additionally, with regard to the rejection of claims 2-4, *Chapman* does not make up for the deficiencies of *Horstmann* noted above. Further, with regard to claim 9, *Netscape Mail Server Administrator's Guide* does not make up for the deficiencies of *Horstmann* as noted above. Further, with regard to claim 15-20, *cc:Mail* does not make up for the deficiencies of *Horstmann* as noted above. Therefore, claims 2-4, 9, and 14-20 are considered patentable over any combination of these documents.

D. Claims 24, 26, and 31-37

Claim 24 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Horstmann* in view of *Netscape Mail Server Administrator's Guide*. Claim 26 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Horstmann* in view of *Chapman*. Claim 31 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Horstmann*. Claims 32-37 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Horstmann* in view of *cc:Mail for Window's User Guide*. For the reasons set forth below, Applicant respectfully traverses the rejection.

Because independent claim 23 is allowable over the prior art of record, dependent claims 24, 26, and 31-37 (which depend from independent claim 23) are allowable as a matter of law for at least the reason that dependent claims 24, 26, and 31-37 contain all the steps/features of independent claim 23. Therefore, since dependent claims 24, 26, and 31-37 are patentable over *Horstmann*, the rejection to claims 24, 26, and 31-37 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 23, dependent claims 24, 26, and 31-37 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 24, 26, and 31-37 are allowable.

Additionally, with regard to the rejection of claims 24, *Netscape Mail Server Administrator's Guide* does not make up for the deficiencies of *Horstmann* as noted above. Further, with regard to claim 32-37, *cc:Mail* does not make up for the deficiencies of *Horstmann*

as noted above. Therefore, claims 24, 26, and 31-37 are considered patentable over any combination of these documents.

**V. Miscellaneous Issues**

Claims 1, 23, and 49 were amended to clarify that the instruction is being applied to an email message other than the message containing the instruction. In contrast, claims 38 and 44 clearly claim that the instructions are applied to a second email message and no amendment for the purpose of clarification is necessary. For this reason, Applicant requests that the next Office Action be non-final.

Claim 47 was amended to overcome an objection due to informalities. No substantive amendment was made for purposes of patentability. Therefore, *Festo* does not apply.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

***CONCLUSION***

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-49 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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**Jeffrey R. Kuester, Reg. No. 34,367**

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500

Customer No. 38823